UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/671,059	09/25/2003	Kyle N. Patrick	CA920020057US1	5839

7590   01/16/2007

David A. Mims, Jr.
International Business Machines,
Intellectual Property Law
11400 Burnet Road
Austin, TX 78758

EXAMINER
KEEFER, MICHAEL E

ART UNIT	PAPER NUMBER
2112	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/16/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

	Application No.	Applicant(s)
Office Action Summary	10/671,059	PATRICK, KYLE N.
	Examiner	Art Unit
	Michael E. Keefer	2112

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**.　　2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-30* is/are pending in the application.

　　4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-30* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *25 September 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

　　Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

　　Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

　　a)☒ All　b)☐ Some *　c)☐ None of:

　　　1.☒ Certified copies of the priority documents have been received.

　　　2.☐ Certified copies of the priority documents have been received in Application No. _____ .

　　　3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

　　* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
　　Paper No(s)/Mail Date _____ .

4) ☐ Interview Summary (PTO-413)
　　Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____ .

DETAILED ACTION

1.   The following office action is in response to the Application filed

9/25/2003.

Priority

2.   Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d),

which papers have been placed of record in the file.

Claim Objections

3.   Claims 1, 3-5, 9-10, 11, 13, 15-16, 19-20, 21, 23, and 25 are objected to

because of the following informalities:

Regarding **claim 1**, the word "the" between "in" and "memory" should be

deleted in line 3, the word "the" should also be deleted between the words

"parsing" and "contents" and between "of" and "said" to improve the clarity of the

claim.

In line 7, the word "said" between "by" and "user" should be deleted and

replaced with the word --a-- to improve the clarity of the claim.

Regarding **claim 3**, the word "a" in line 2 between "by" and "user" should

be deleted and replaced with the word --said-- to improve the clarity of the claim.

Regarding **claim 4**, the word "a" in line 1 between "initiating" and "reply"

should be deleted and replaced with the word --said-- to improve the clarity of the

claim.

Regarding **claim 5**, the word "said" in line 2 should be deleted and

replaced with --a-- to improve the clarity of the claim.

Regarding **claim 9**, the word "response" in line 1 should be deleted and replaced with --reply-- to improve the clarity of the claim.

The word "addresses" in line 2 should be deleted and replaced with the word --addresses.-- to improve the clarity of the claim.

Regarding **claim 10**, the word "response" in line 1 should be deleted and replaced with --reply-- to improve the clarity of the claim.

Regarding **claim 11**, in line 5 the word "for::" should be deleted and replaced with the word --for:-- to improve the clarity of the claim.

The word "the" in line 6 between "parsing" and "contents" should be deleted as well as the word "the" in line 6 between "of" and "said".

The word "the" in line 7 should be deleted to improve the clarity of the claim.

The word "said" in line 10 between "by" and "user" should be deleted and replaced with the word --a-- to improve the clarity of the claim.

Regarding **claim 13**, the word "a" in line 2 should be deleted and replaced with the word --said-- to improve the clarity of the claim.

Regarding **claim 14**, the word "a" in line 1 should be deleted and replaced with the word --said-- to improve the clarity of the claim.

Regarding **claim 15**, the word "said" in line two should be deleted and replaced with the word --a-- to improve the clarity of the claim.

Regarding **claim 16**, the word "message" at the end of line 2 should be deleted and replaced with the word --message.-- to improve the clarity of the claim.

Regarding **claim 19**, the word "response" in line 1 should be deleted and replaced with --reply-- to improve the clarity of the claim.

Regarding **claim 20**, the word "response" in line 1 should be deleted and replaced with --reply-- to improve the clarity of the claim.

Regarding **claim 21**, the word "the" in line 5 should be deleted to improve the clarity of the claim.

The word "the" in line 6 between "parsing" and "contents" should be deleted as well as the word "the" in line 6 between "of" and "said" to improve the clarity of the claim.

The word "said" in line 9 between "by" and "user" should be deleted and replaced with the word --a-- to improve the clarity of the claim.

Regarding **claim 23**, the word "a" in line 2 should be deleted and replaced with the word --said-- to improve the clarity of the claim.

Regarding **claim 25**, the word "said" in line two should be deleted and replaced with --a-- to improve the clarity of the claim.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

4.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5.   Claims 1, 6, 11, 16, 21, and 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding **claims 1, 11, and 21**, the word "recipients" in the last line of

the claim is confusing because line 1 of the claim also recites "recipients" and it is

unclear whether the recipients recited in both places are actually the same or not.

Regarding **claims 6, 16, and 26**, the phrase "said message" in line 2 of

the claim is confusing because it is unclear to what previously recited message is

being referred to; the "received email message" or the "reply email message".

Claim Rejections - 35 USC § 101

6.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or
> composition of matter, or any new and useful improvement thereof, may obtain a patent
> therefor, subject to the conditions and requirements of this title.

Claims 1-30 are rejected under 35 U.S.C. 101 because the claimed invention is

directed to non-statutory subject matter.

Regarding **claim 1**, which is directed to a method of selecting recipients of

an email message. As stated in applicant's disclosure on page 5 in paragraph 2,

the invention may be embodied as computer software code, which is merely

functional descriptive material and therefore is non-statutory, as functional

descriptive material does not fall under one of the four statutory categories of

invention.

Claims 2-10 fail to add any statutory subject matter to the claim, and so

are rejected for the same.

Regarding **claim 11**, which is drawn to "a computer program product". In

order for a claim to be statutory it must be drawn to a process, article of

manufacture, composition of matter, or machine. In accordance with Applicant's

specification "a computer usable medium" may include "a computer readable

modulated carrier signal". (Page 5, paragraph 2) This subject matter is not limited

to that which falls within a statutory category of invention because it is not limited

to a process, machine, manufacture, or a composition of matter. Instead, it

includes a form of energy. Energy does not fall within a statutory category since it

is clearly not a series of steps or acts to constitute a process, not a mechanical

device or combination of mechanical devices to constitute a machine, not a

tangible physical article or object which is some form of matter to be a product

and constitute a manufacture, and not a composition of two or more substances

to constitute a composition of matter.

Claims 12-20 do not remove any non-statutory matter from the claim,

therefore are rejected for the same.

Regarding claim 21, which is drawn to an article comprising a modulated

carrier signal. Applicant's specification on page 5 in paragraph 2 states, "The

invention may also be embodied on a computer readable modulated carrier

signal." This subject matter is not limited to that which falls within a statutory

category of invention because it is not limited to a process, machine,

manufacture, or a composition of matter. Instead, it includes a form of energy.

Energy does not fall within a statutory category since it is clearly not a series of

steps or acts to constitute a process, not a mechanical device or combination of

mechanical devices to constitute a machine, not a tangible physical article or

object which is some form of matter to be a product and constitute a

manufacture, and not a composition of two or more substances to constitute a

composition of matter.

Claims 22-30 do not remove the non-statutory subject matter from the

claim and therefore are rejected for the same.

In addition, **claim 21** is directed merely to functional descriptive material

as stated in applicant's specification on page 5 in paragraph 2, "[The present

invention] may also be embodied as ... computer software code ..." This subject

matter is not limited to that which falls within a statutory category of invention

because it is not limited to a process, machine, manufacture, or a composition of

matter. Instead, it includes functional descriptive material. Functional descriptive

material does not fall within a statutory category since it is clearly not a series of

steps or acts to constitute a process, not a mechanical device or combination of

mechanical devices to constitute a machine, not a tangible physical article or

object which is some form of matter to be a product and constitute a

manufacture, and not a composition of two or more substances to constitute a

composition of matter.

Claims 22-30 do not remove the non-statutory subject matter from the

claim and therefore are rejected for the same.

Double Patenting

7.   The nonstatutory double patenting rejection is based on a judicially
created doctrine grounded in public policy (a policy reflected in the statute) so as
to prevent the unjustified or improper timewise extension of the "right to exclude"
granted by a patent and to prevent possible harassment by multiple assignees.
A nonstatutory obviousness-type double patenting rejection is appropriate where
the conflicting claims are not identical, but at least one examined application
claim is not patentably distinct from the reference claim(s) because the examined

application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8.   Claims 1, 9, 11, and 19 are rejected on the ground of nonstatutory

obviousness-type double patenting as being unpatentable over claims 1, 3, 4,

and 6 of U.S. Patent No. 6,823,368. Although the conflicting claims are not

identical, they are not patentably distinct from each other because:

Regarding claim 1 of the instant application which recites:

A method of selecting recipients of an e-mail message for transmission by

a recipient computer in reply to a received e-mail message comprising:

i) storing said received e-mail message in the memory of said recipient

computer; (This step is inherent in claim 1 of '368, as in order to manipulate and

read the message it must be stored in some memory.)

ii) parsing the contents of the said received email for e-mail addresses and

forming a list of said parsed e-mail addresses; (Claim 1 of '368 recites "searching

said body section of said electronic mail message for said chain sender

addresses of senders having send said message")

iii) displaying said list of parsed e-mail addresses; (it would have been obvious to one of ordinary skill in the art at the time of the invention to omit the step of displaying the list of parsed email addresses in order to streamline the program flow) and

iv) forming a reply e-mail message to recipients selected from said list by said user. (Claim 1 of '368 recites: adding a Sender-chain field to an e-mail message header section when forwarding the chain forwarded email message to another recipient.)

Regarding claim 9 of the instant application, which is dependent on claim 1 as shown above, adds the limitation the reply message is formed by auto-populating SMTP headers with the list of email addresses. This step is clearly recited in claim 3 of '368, which is dependent on claim 1 of '368 used above (adding a sender-chain field to a SMTP message).

Claims 11 and 19 of the instant application are identical to claims 1 and 9 of the instant application except for the recitation of a computer program product and computer readable media. Claims 4 and 6 of '368 recite the same limitations of claims 1 and 3 of '368 except for claiming computer-readable media; therefore claims 11 and 19 are rejected for the same reasons as cited above for claims 1 and 9.

Claim Rejections - 35 USC § 102

9.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10.   Claims 1 and 3 are rejected under 35 U.S.C. 102(b) as being anticipated by Hara (US 5938725).

Regarding **claim 1**, Hara discloses:

A method of selecting recipients of an e-mail message for transmission by a recipient computer in reply to a received e-mail message comprising:

i) storing said received e-mail message in the memory of said recipient computer; (storage means for storing therein a received electronic mail Col 2. lines 58-59)

ii) parsing the contents of the said received email for e-mail addresses and forming a list of said parsed e-mail addresses; (extracting means for extracting a mail address contained in the electronic mail Col. 2 lines 64-65)

iii) displaying said list of parsed e-mail addresses; (Col 4 Lines 2-8, "outputted as the transmission destination candidates") and

iv) forming a reply e-mail message to recipients selected from said list by said user. (Col 4 lines 8-11 "the user can readily transmit the electronic mail by merely selecting his desired transmission destination from these outputted transmission destination candidates.)

Regarding **claim 3 and as applied to claim 1** Hara discloses:

wherein said list of parsed e-mail addresses is displayed in response to an action by a user. (Col 3, lines 4-9, the process of extraction is started by the user inputting a keyword from an input device.)

11.   Claims 1-3, 5-6, 11-13, 15-16, 21-23, and 25-26 are rejected under 35

U.S.C. 102(b) as being anticipated by Birrell et al. (US 6189026 B1) hereafter

Birrell.

    Regarding **claims 1, 11, and 21**, Birrell discloses:

    A method of selecting recipients of an e-mail message for transmission by

a recipient computer in reply to a received e-mail message comprising:

    i) storing said received e-mail message in the memory of said recipient

computer; ("Mail messages are stored in message files of the mail service

system" Abstract)

    ii) parsing the contents of the said received email for e-mail addresses and

forming a list of said parsed e-mail addresses; (Col 12, lines 16-18 "the system

heuristically locates text strings which have the syntax of email addresses")

    iii) displaying said list of parsed e-mail addresses; (Col 12 lines 18-19 "if

the user clicks on one of these addresses, inherently the list of addresses must

be displayed in order for a user to click on them) and

iv) forming a reply e-mail message to recipients selected from said list by said

user. (Col 12 lines 18-21 "If a user clicks on one of these addresses then the

system will display a composition window so that the user can easily generate a

reply message to the selected email address(es).)

    Birrell discloses that his method can be computer implemented, therefore

must be able to be implemented on a computer readable media as recited in

claim 11 or a computer readable carrier wave as recited by claim 21.

Regarding **claims 2, 12, and 22 and as applied to claims 1, 11, and 21,**
Birrell discloses:

wherein said received e-mail message is a multi-party e-mail. (The reply to
all function described in Col 14 lines 36-38 clearly shows that emails with multiple
parties are included by the disclosed email system.)

Regarding **claims 3, 13, and 23 and as applied to claims 1, 11, and 21,**
Birrell discloses:

wherein said list of parsed e-mail addresses is displayed in response to an
action by a user. (Col 12, lines 16-17 disclose that "When displaying retrieved
messages" and choosing to display a message is a user action.)

Regarding **claim 5, 15, and 25 and as applied to claims 1, 11, and 21,**
Birrell discloses:

wherein said recipient computer parses said received e-mail message
automatically prior to said user action. (Col. 7 lines 23-24 state that messages
are processed in batches as they are received.)

Regarding **claim 6, 16, and 26 and as applied to claims 1, 11, and 21,**
Birrell discloses:

wherein said recipient computer parses said received e-mail message
automatically upon receipt of said message. (Col. 7 lines 23-24 state that
messages are processed in batches as they are received.)

12.   The following is a quotation of the appropriate paragraphs of 35
U.S.C. 102 that form the basis for the rejections under this section made in this
Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

13.   Claims 1-4, 7-10, 11-14, 17-20, 21-24, 27-30 are rejected under 35 U.S.C.

102(e) as being anticipated by Ullmann et al. (US 7103634 B1) hereafter

Ullmann.

The applied reference has a common assignee with the instant

application. Based upon the earlier effective U.S. filing date of the reference, it

constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C.

102(e) might be overcome either by a showing under 37 CFR 1.132 that any

invention disclosed but not claimed in the reference was derived from the

inventor of this application and is thus not the invention "by another," or by an

appropriate showing under 37 CFR 1.131.

Regarding **claims 1, 11, and 21**, Ullmann discloses:

A method of selecting recipients of an e-mail message for transmission by

a recipient computer in reply to a received e-mail message comprising:

i) storing said received e-mail message in the memory of said recipient ˊ

computer; (this step is inherent as the message must be stored in memory of the

computer)

ii) parsing the contents of the said received email for e-mail addresses and

forming a list of said parsed e-mail addresses; (Col 8 lines 55-57 "scanning the

attached or inline header fields of the original message")

iii) displaying said list of parsed e-mail addresses; (the "special field"

disclosed in line 54 would display the results of the scanning above) and

iv) forming a reply e-mail message to recipients selected from said list by

said user. (Figure 4 step 47 of fully incorporated application 09/672,181 shows

that the built list of previous senders and recipients can be used to provide

automatic addressing for a reply or forwarded message.)

Ullmann discloses that his method can be computer implemented,

therefore must be able to be implemented on a computer readable media as

recited in claim 11 or a computer readable carrier wave as recited by claim 21.

Regarding **claims 2, 12, and 22 and as applied to claims 1, 11, and 21**,

Ullmann discloses:

wherein said received e-mail message is a multi-party e-mail. (Ullmann

specifically discloses that chain messages (i.e. multi-party emails) are processed

using his method, "An enhanced e-mail reader and composer having automatic

addressing functions to create and manage chain groups for organizing chain-

forwarded and chain-replied messages" abstract.)

Regarding **claims 3, 13, and 23 and as applied to claims 1, 11, and 21**,

Ullmann discloses:

wherein said list of parsed e-mail addresses is displayed in response to an

action by a user. (Fig. 4 of fully incorporated application 09/672,181 where the

step of opening and displaying an email is directly followed by the scanning of

the email, therefore the act of the user opening the email causes the scanning.)

Regarding **claims 4, 14, and 24 and as applied to claims 1, 3, 11, 13, 21, and 23**, Ullmann discloses:

wherein said user action comprises initiating a reply message. (Col 10, lines 21-42, where it is described that after a reply message is started a list of possible recipients, "one or more found previous recipients and originators" in lines 34-35)

Regarding **claims 7, 17, and 27 and as applied to claims 1, 11, and 21**, Ullmann discloses:

wherein said recipient computer loads and displays said received email for viewing by said user prior to said parsing step. (In fully incorporated application 09/672181, Col. 6 lines 14-16 states that first the message is opened and displayed, then it is scanned.)

Regarding **claims 8, 18, and 28 and as applied to claims 1, 11, and 21**, Ullmann discloses:

wherein prior to said parsing step said user requests a list of potential reply e-mail addresses. (Col 10, when the user asks to make a reply message, the message is parsed in order to find possible reply candidates as inherently part of forming a reply requires a user to specify to whom the message is going to.

Regarding **claims 9, 19, and 29 and as applied to claims 1, 11, and 21**, Ullmann discloses:

wherein said response message is formed by auto-populating SMTP headers with said list of e-mail addresses (Col. 9 lines 18-22 disclose populating

the reply-to field of the email automatically with the addresses found in the

search of the email.)

Regarding **claims 10, 20, and 30 and as applied to claims 1, 11, and

21**, Ullmann discloses:

wherein said response message is formed by auto-populating user

interface graphical elements. (Col 10 lines 29-36 describes that the user is

prompted to create an address book entry for a group, in which the group is

automatically filled with addresses found in the search of the email.)

Conclusion

Any inquiry concerning this communication or earlier communications from

the examiner should be directed to Michael E. Keefer whose telephone number

is (571) 270-1591. The examiner can normally be reached on Monday-Thursday

8am-5pm, second Fridays 8am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the

examiner's supervisor, Frantz Jules can be reached on (571) 270-1808. The fax

phone number for the organization where this application or proceeding is

assigned is 571-273-8300.

Information regarding the status of an application may be obtained from

the Patent Application Information Retrieval (PAIR) system. Status information

for published applications may be obtained from either Private PAIR or Public

PAIR. Status information for unpublished applications is available through

Private PAIR only. For more information about the PAIR system, see http://pair-

direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-

free). If you would like assistance from a USPTO Customer Service

Representative or access to the automated information system, call 800-786-

9199 (IN USA OR CANADA) or 571-272-1000.

MEK 1/3/2007

FRANTZ JULES
SUPERVISORY PATENT EXAMINER